THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte JAMES R. MASON,
RICHARD A. DOLBEER
and GEORGE PRETI

_____

Appeal No. 94-0291
Application 07/490,760[1]

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ON BRIEF

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Before METZ, GRON and ELLIS , ***Administrative Patent Judges***.

ELLIS, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 2, 4 through 12, 19 through 23, and 50 through 52, all the claims pending in the application.

Claim 1 is illustrative of the subject matter on appeal and reads as follows:

1. A method of repelling carnivorous or omnivorous animals selected from the group

[1] Application for patent filed March 8, 1990. According to appellants, this application is a continuation-in-part of Application 07/394,932, filed August 17, 1989, now abandoned; which is a continuation-in-part of Application 07/351,841, filed May 12, 1989, now abandoned.

consisting of domestic cats, rodents, raccoons and canids comprising applying to the locus from which said animals are to be repelled an effective repellent amount of one or more volatile compounds selected from the group consisting of pulegone and piperitone.

The references relied on by the examiner are:

Freeman 3,474,176 Oct. 21, 1969

Inazuka, ***Chemical Abstracts***, Vol. 100, p. 196, Abstract No. 116461p (1984).

Claims 1, 2, 4 through 12, 19 through 23, and 50 through 52 stand rejected under 35 U.S.C. § 103 as being unpatentable over Freeman alone or in view of Inazuka.

We **reverse** both rejections primarily for the reasons set forth in the appellants' Brief (Paper No. 14) and Reply Brief (Paper No. 16). In addition, we **remand** this case to the examiner for further consideration of the scope of the claims.

The subject matter on appeal, as set forth in claim 1 above, is directed to a method of repelling animals using pulegone and/or piperitone. According to the specification, pulegone and piperitone are volatile compounds which exhibit a mint-like odor. Specification, p. 1, para. 2.

The examiner's first rejection is predicated solely on the teachings of Freeman, a reference which discloses a method of repelling carnivorous animals such as bears, wolves, coyotes, etc. and small animals such as rats, mice and squirrels. The method involves the use of a repellent comprising a carrier and an aliphatic or alicyclic ketone containing from about 6 to about 20 carbon atoms, wherein said ketones can be saturated or unsaturated aliphatic or alicylcic materials. Freeman, col. 1, lines 13-18, and col. 2, lines 4-8. The preferred ketones are ethylbutyl

ketone, methylisoamyl ketone, 4-*t*-amylcyclohexanone and methylnonyl ketone. ***Id.***, col. 2, lines 16-20.

The examiner points out that Freeman teaches that compositions containing alicyclic ketones of 6-20 carbon atoms are effective for repelling animals. From this teaching the examiner concludes that

> [i]t would have been obvious to one of ordinary skill in the art to substitute piperitone and pulegone, alicyclic ketones of 10 carbons each, for the animal repellents of Freeman which teaches similar alicyclic ketones for use as animal repellents with a high expectation that said materials would function as suggested by Freeman, i.e. as repellents [Answer, p. 3].

We disagree. As developed in the Brief, there are significant structural differences between pulegone and piperitone and the ketones disclosed by Freeman. For example, we direct attention to the structural comparisons set forth on pp. 4-5 of the Brief. On this record, we do not find that the examiner has even begun to establish that, based on the teachings of Freeman, one of ordinary skill in the art would have found it obvious to select the claimed compounds for use in repelling animals. Rather, we only find sweeping statements by the examiner, such as "[p]iperitone and pulegone clearly fall within the scope or general subject matter of those compounds disclosed by the reference [Freeman]." Answer, p. 4, lines 11-12. See also, the supplemental Answer, para. bridging pp. 1-2. Such statements do not indicate the motivation, if there is any, for a person having ordinary skill in the art to use pulegone and piperitone to repell mammals. Here, the only teaching we find that ties the claimed method of using pulegone and piperitone to the teachings of Freeman, is the appellants' disclosure. Thus, in our opinion, the

examiner has relied on "hindsight" to arrive at the conclusion the claimed method would have been obvious over the applied prior art. ***In re Fritch***, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992); ***Interconnect Planning Corp v. Feil***, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

The examiner also urges that the claimed method would have been obvious to one of ordinary skill in the art over the combined teachings of Freeman and Inazuka. Inazuka is an abstract which discloses that pulegone was found to be useful in repelling German cockroaches by test tube and beaker methods. According to the examiner

> [t]he compounds of Freeman and Inazuka are both alicyclic ketones and would have been expected to possess similar repellent characteristics relative to mammals. Similarly, the formulation of compositions for this purpose would have been obvious from the disclosure of the Freeman reference [Answer, p. 3].

Here, we acknowledge that Inazuka discloses the repellent properties of pulegone with respect to German cockroaches, however, we disagree with the examiner's reasoning in reaching her conclusion of obviousness. We find no teaching or suggestion in the combined teachings of the applied prior art, and none has been pointed out by the examiner, which supports her conclusion that the use of pulegone as a repellent for mammals "would have been obvious from the disclosure of the Freeman reference." Answer, p. 3. Accordingly, we find that the examiner has not provided a sufficient basis for concluding that the claimed method would have been ***prima facie*** obvious to one of ordinary skill in the art at the time the application was filed. A conclusion of obviousness must be based on fact(s) and not unsupported generalities. ***In re Freed***, 425 F.2d

785, 788, 165 USPQ 570, 572 (CCPA 1970); ***In re Warner***, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967).

Accordingly, the rejections over the applied prior art are reversed.

REMAND

Upon return of this application the examiner is instructed to reconsider the scope of the claimed invention. That is, the claimed method requires the application of pulegone and/or piperitone to a locus. In some instances, the locus is defined as being a trash receptacle (claims 19 and 22) or a poison (claims 20 and 21), however, it does not appear that one of the claims is limited to a locus which requires the presence of any particular animal type. Thus, the examiner should consider whether (i) the claims are actually limited to a method of repelling "carnivorous or omnivorous animals selected from the group consisting of domestic cats, rodents, raccoons and canids," or (ii) the claims encompass the application of pulegone and/or piperitone to a locus for the purpose of repelling any animal or insect, such as cockroaches, wherein such application would inherently result in the repulsion of any cats, rodents, raccoons, and canids which happen to pass in the vicinity of said locus. ***See In re Woodruff***, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990) ("It is a general rule that merely discovering and claiming a new benefit of an ***old*** process cannot render the process again patentable") .

In the event the examiner determines that the latter of the two aforementioned interpretations of the claims is reasonable, then the examiner should consider whether the teachings of the Inazuka abstract, or other prior art teachings as to the use of the claimed

compounds as animal or insect repellents, anticipates or would have rendered the claimed method obvious to one of ordinary skill in the art. That is, would teachings of the use of pulegone to repell German cockroaches by the test tube and beaker methods as described by Inazuka have suggested the claimed method of applying pulegone and/or piperitone to any locus, or to a trash receptacle or a poison such as antifreeze, or placed said method in the possession of the public.

REVERSED AND REMANDED

ANDREW H. METZ Administrative Patent Judge	)
TEDDY S. GRON Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
JOAN ELLIS Administrative Patent Judge	)

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